

### **REMARKS**

This paper includes a complete and timely response to the non-final Office Action mailed May 27, 2004. Claims 2 - 22 and 25 - 30 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

In response to the rejection of claims 2 - 22 and 25 - 30, Applicants submit that the proposed combination of *Flowers* in view of *Ying* does not disclose, teach, or suggest all claim limitations.

#### **Response to 35 U.S.C. §103 Rejections – Claims 2 – 22 and 25 - 30**

##### **A. Statement of the Rejection**

The Office Action indicates that claims 2 - 22 and 25 - 30 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 5,533,174 to *Flowers et al.* ("*Flowers*") in view of International Publication Number WO 01/18681 A2 to *Ying et al.* ("*Ying*.")

##### **B. Discussion of the Rejection**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicants respectfully traverse the rejection of claims 2 - 22 and 25 - 30 for at least the reason that the cited references fail to disclose, teach, or suggest each element and/or feature recited in the claims. Applicants respectfully request that the Office reconsider the rejection.

##### **1. Claims 2 – 15 and 28**

For convenience of analysis, Applicants' independent claim 7 is repeated below in its entirety.

7. A method for distributing and installing print device fonts, the method comprising:
  - maintaining a web site which facilitates selection from a set of print device-ready fonts;
  - via the web site, obtaining information concerning a visitor's system configuration;

via the web site, receiving a request for a set of fonts for purchase;

via the web site, displaying potential estimated performance gains that may result from the purchase of a set of fonts other than the set of fonts requested by the visitor, ***wherein potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font;***

via the web site, permitting selection, by the visitor, from the set of fonts requested and the set of fonts other than the set of fonts requested;

via the web site, authorizing transfer of the set of fonts selected; and

via the web site, installing the set of fonts selected on a print device corresponding to the visitor.

(Applicants' Claim 7 - *emphasis added*.)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed invention obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 7. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest "***potential estimated performance gains comprise a characteristic of a print job executed with a print device installed font.***"

The proposed combination of *Flowers* and *Ying* fails to describe Applicants' claimed potential estimated performance gains. *Ying* apparently discloses (FIGs. 68 and 71 - 74) a graphical user interface associated with a browser (*i.e.*, Netscape) that shows a "best match" score associated with a plurality of available fonts. The best match score compares attributes of a sample portion of text provided by a visitor to the Web site with attributes associated with each of the available fonts. *Ying* further describes displaying sample text on a test drive web page using a user-selected font selected from the available fonts. *Ying*'s best-match score and test drive pages do not disclose, teach, or suggest Applicant's method. Graphically presenting a score associated with a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant's claimed feature that defines "***potential estimated performance gains***" as a "***characteristic of a print job executed with a print device installed font.***" Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job executed with a print device installed font. Rendering sample text on a

display device also does not suggest a potential estimated performance gain associated with a print job executed with a print device installed font. For at least these reasons, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants' claimed invention. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants' amended claim 7. Accordingly, independent claim 7 is allowable and the rejection should be withdrawn.

Because independent claim 7 is allowable, as discussed above, dependent claims 2 - 6, 8 - 15, and 28, which depend either directly or indirectly from independent claim 7, are also allowable. *See In re Fine*, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 2 - 15 and 28 be withdrawn.

## **2. Claims 16, 26, and 29**

For convenience of analysis, Applicants' independent claim 16 is repeated below in its entirety.

16. A method for distributing print device fonts, the method comprising:

- receiving information corresponding to a visitor accessing a web site, the web site providing a selection of fonts for purchase by the visitor;

- receiving information, via the web site, corresponding to the visitor designating one or more of the fonts for purchase;

- determining a visitor's system configuration;

- displaying potential estimated performance gains, based upon the visitor's system configuration, resulting from installation of one or more fonts other than the one or more of the fonts designated, ***wherein potential estimated performance gains comprise a characteristic of a print job***;

- receiving information corresponding to the visitor selecting for purchase one or more of the fonts designated or one or more of the fonts other than the fonts designated; and

- from the web site, in response to a purchase by the visitor, installing said selected one or more of the fonts on a print device of the visitor.

(Applicants' Claim 16 - *emphasis added*.)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed method for distributing print device fonts obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 16. Specifically, neither *Flowers* nor *Ying* disclose, teach, or suggest that "***potential estimated performance gains comprise a characteristic of a print job.***"

As discussed above regarding Applicants' independent claim 7, the statement of the rejection acknowledges that *Flowers* does not disclose this limitation.

Applicants further respectfully submit that the proposed combination of *Flowers* and *Ying* fails to describe Applicants' claimed potential estimated performance gains. *Ying*'s best-match score and test drive pages do not disclose, teach, or suggest Applicant's method. Graphically presenting a score on a display device derived from a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant's claimed feature that defines "***potential estimated performance gains***" as a "***characteristic of a print job.***" Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job. Rendering sample text on a display device also does not suggest a potential estimated performance gain associated with a print job. For at least these reasons, the proposed combination fails to disclose, teach, or suggest each method limitation recited in Applicants' claimed method for distributing print device fonts. Thus, the proposed combination fails to establish a *prima facie* case of obviousness for Applicants' amended claim 16. Accordingly, independent claim 16 is allowable and the rejection should be withdrawn.

Because independent claim 16 is allowable, as discussed above, dependent claims 26 and 29, which depend from independent claim 16, are also allowable. *See In re Fine, supra.* Accordingly, Applicants respectfully request that the rejection of claims 16, 26, and 29 be withdrawn.

### **3. Claims 17 – 22, 27 and 30**

For convenience of analysis, Applicants' independent claim 17 is repeated on the following page in its entirety.

17. A web site for distributing print device fonts, the web site being accessible over the Internet and comprising software for:

    permitting a visitor to select fonts compatible with that visitor's system configuration;

    displaying potential estimated performance gains which may result from installation of a font not previously selected by the visitor, ***wherein potential estimated performance gains comprise a characteristic of a print job;***

    determining whether to authorize installation of a selected one or selected multiple compatible fonts; and

    installing said selected one or selected multiple compatible fonts on a visitor's print device in response to an authorization determined in said step of determining.

(Applicants' Claim 17 - *emphasis added*.)

Applicants respectfully submit that the proposed combination of *Flowers* in view of *Ying* does not render Applicants' claimed web site obvious for at least the reason that neither *Flowers* nor *Ying* disclose, teach, or suggest at least the emphasized limitation of claim 17. Specifically, the proposed combination of *Flowers* and *Ying* fails to disclose, teach, or suggest Applicants' claimed limitation that defines "***potential estimated performance gains***" as "***a characteristic of a print job.***"

The proposed combination of *Flowers* and *Ying* fails to disclose, teach, or suggest Applicants' claimed potential estimated performance gains. *Ying*'s best-match score and test drive pages do not disclose, teach, or suggest Applicant's claimed web site. Graphically presenting a score on a display device derived from a comparison of font attributes and presenting sample text rendered on a display with a user selected font does not disclose, teach, or suggest Applicant's claimed feature that defines potential estimated performance gains as a "***characteristic of a print job.***" Graphically presenting the result of a font comparison analysis does not suggest a potential estimated performance gain associated with a print job. Rendering sample text on a display device also does not suggest a potential estimated performance gain associated with a print job. For at least these reasons, the proposed combination fails to disclose, teach, or suggest each feature recited in Applicants' claimed web site. Thus, the proposed combination fails to establish a *prima facie* case of obviousness in view of claim 17. Accordingly, independent claim 17 is allowable and the rejection should be withdrawn.

Because independent claim 17 is allowable, as discussed above, dependent claims 18 - 22, 27, and 30, which depends from independent claim 17, are also allowable. *See*

*In re Fine, supra.* Accordingly, Applicants respectfully request that the rejection of claims 17 - 22, 27, and 30 be withdrawn.

**Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

**CONCLUSION**

For at least the reasons set forth above, Applicants respectfully submit that pending claims 2 - 22 and 25 - 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**

By:



Robert A. Blaha

Registration No. 43,502

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**

100 Galleria Parkway, Suite 1750  
Atlanta, Georgia 30339-5948  
(770) 933-9500